

## REMARKS

Applicants submit this Amendment in reply to the Office Action mailed September 23, 2004.

By this Amendment, Applicants cancel claims 1-20, without prejudice or disclaimer, and add new claims 21-34. The originally-filed specification, claims, and drawings fully support the subject matter of new claims 21-34. Claims 21 and 24 are the sole independent claims.

On page 2 of the Office Action, claims 1-17 were rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,731,357. Claims 1-17 have been cancelled, rendering that rejection moot.

On pages 2-3 of the Office Action, claims 7 and 8 were rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. Claims 7 and 8 have been cancelled, rendering that rejection moot. In addition, Applicants respectfully submit that new claims 21-34 are clear and definite. Regarding claims 21 and 24, Applicants would like to clarify that the film has a length of "at least 1000 m."

On page 3 of the Office Action, claims 1 and 11 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,183,829 to Deacher et al. ("Deacher"). Claims 1 and 11 have been cancelled, rendering that rejection moot. Insofar as the rejection may be applied to new claims 21-34, Applicants respectfully traverse the §102(e) rejection. For anticipation under 35 U.S.C. §102, the reference must teach every aspect of the claimed invention either explicitly or implicitly. M.P.E.P. 706.02. Because Daecher does not teach every aspect of claims 21 and 24 either

alone or in combination with the other aspects of the claimed invention, Daecher does not anticipate any of those claims.

Daecher does not disclose or suggest the invention claimed in either of independent claims 21 or 24. For example, independent claim 21 recites an apparatus for forming an optical film including, among other aspects, "a winding section winding film in a roll over a length of at least 1000 m, wherein the film has film thickness of 20 to 60  $\mu\text{m}$  and variation in the film thickness within  $\pm 3.0$  percent of the standard film thickness." Independent claim 24 recites a method for forming an optical film including, among other aspects, "winding the film in a roll over a length of at least 1000 m, wherein the film has film thickness of 20 to 60  $\mu\text{m}$  and variation in the film thickness within  $\pm 3.0$  percent of the standard film thickness." Daecher does not disclose any of these aspects of the invention either alone or in combination with the other aspects of the claimed invention.

Specifically, Daecher discloses an apparatus and process for forming a plastic sheet, but does not disclose either an apparatus or a method including a film as recited, respectively, in claims 21 and 24. The only dimensions for the film that Daecher discloses is a 400x400 mm piece cut from the cooled sheet, and not "at least 1000 m" as recited in each of claims 21 and 24. Daecher does disclose a film having an average thickness of 54  $\mu\text{m}$  with variation of 4  $\mu\text{m}$ . (Col. 17, lines 23-26). However, a variation of 4  $\mu\text{m}$  for a thickness of 54  $\mu\text{m}$  is  $\pm 7.4\%$ , and not  $\pm 3.0$  percent as recited in claim 1. While, the Examiner may assert that the  $\pm 7.4\%$  recited in Daecher encompasses the claimed range of  $\pm 3.0$  percent and thus anticipates it, "[i]f the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of

unexpected results within the claimed narrow range... it may be reasonable to conclude that the narrow range is not disclosed with 'sufficient specificity' to constitute an anticipation of the claims." M.P.E.P. § 2131.03. This section of the M.P.E.P. is applicable here as Applicants have set forth, on pages 5-7 of the specification, the importance of the claimed range of  $\pm 3.0$  percent.

Further, as the results of the detailed investigation on the ratio of wrinkle formation as well as variation in film thickness, it has been discovered that at the film thickness of no more than 60  $\mu\text{m}$ , when variation in film thickness is within  $\pm 3.0$  percent of the standard thickness (average film thickness) of said film is preferably  $\pm 2.9$  percent, and is more preferably  $\pm 2.8$  percent, wrinkles, which are not permitted as the polarizing plate protective film, are not formed. (Page 5 of the specification).

When the variation in the film thickness is controlled within  $\pm 3.0$  percent of the standard film thickness, in the case of a thin film in the range of 20 to 60  $\mu\text{m}$ , especially in the range of 25 to 55  $\mu\text{m}$ , and further in the range of 30 to 55  $\mu\text{m}$ , wrinkles are not substantially formed. Namely, wrinkles which are not permitted in the film for a liquid crystal display unit, especially a polarizing plate protective film, are not substantially formed. For example, when a 5000 m long film is wound, wrinkles, which are not permitted in the polarizing plate protective film, are not formed. As a result, the production yield increases. (Pages 6-7 of the specification).

Accordingly, because Daecher does not disclose every aspect of the invention either alone or in combination with the other aspects of the claimed invention, Applicants respectfully assert that the Section 102(e) rejection cannot be applied to any of claims 21-34.

On pages 3-5 of the Office Action, claims 1-4, 6-14, 16, and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,139,785 to Shuto et al. ("Shuto") in view of Daecher; claims 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Shuto and Daecher in view of U.S. Patent No. 4,820,813 to Schulz ("Schulz"); and claims 15, and 18-20 were rejected under 35 U.S.C.

§103(a) as being unpatentable over Shuto and Daecher in view of U.S. Patent No. 4,427,741 to Aizawa et al. ("Aizawa") and U.S. Patent No. 4,726,659 to Conrad et al. ("Conrad"). Applicants have cancelled claims 1-20, rendering the rejections moot. Insofar as the rejection may be applied to new claims 21-34, Applicants respectfully traverse the rejection. No proper combination of the cited references, including Daecher, Shuto, Schulz, Aizawa, Conrad, and the other art of record, discloses or suggests the present invention as claimed in independent claim 21 and 24.

For example, the Examiner admits that Shuto does not disclose "variation in the film thickness within  $\pm 3.0$  percent of the standard film thickness," as set forth in each of independent claims 21 and 24. Daecher is then cited, however, as disclosing this aspect of the claimed invention. As set forth above with respect to the §102(e) rejection, however, Daecher does not disclose or suggest this aspect of each of claims 21 and 24, and Applicants assert that neither Schulz, Aizawa, or Conrad remedy this deficiency. Accordingly, Applicants respectfully assert that the Section 103(a) rejections cannot be applied to any of claims 21-34.

Applicants further submit that claims 22-23 and 25-34 depend from one of independent claims 21 and 24, and are therefore allowable for at least the same reasons that each of those respective independent claims is allowable. In addition, at least some of the dependent claims recite unique combinations that are neither taught nor suggested by Daecher, Shuto, Schulz, Aizawa, or Conrad, and therefore at least some also are separately patentable.

In view of the foregoing remarks, Applicants submit that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references

cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.


In discussing the specification, claims, abstract, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

If there is any fee not otherwise provided herewith that is due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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